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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/769,245	01/30/2004	Hsin-Hsien Lu	67,200-1192	8175

7590 08/08/2005

TUNG & ASSOCIATES
Suite 120
838 W. Long Lake Road
Bloomfield Hills, MI 48302

EXAMINER

KORNAKOV, MICHAIL

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 08/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/769,245

Applicant(s)

LU ET AL.

Examiner

Michael Kornakov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicants' election of claims 1-16 in the reply, filed 06/13/2005 is acknowledged. While the election is made with traverse, Applicants have failed to point out wherein either (1) the reasons advanced by the Examiner to establish distinctiveness between the inventions as claimed and grouped or (2) the evidence of separate status, classification and/or search are in error. Therefore the restriction requirement is made **FINAL**. Claims 17-20 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Claims 1-16 are currently examined on the merits.

Specification

2. The disclosure is objected to because of the following informalities:

Page 15, paragraph 0035, recites "Most preferably, the surfactant is applied to a polished layer after each polishing step in the polishing sequence." Apparently, the surfactant composition **solution** is applied to a polished layer.

Page 16, paragraph 0038, provides the formula for octanol as (C₂₀H₂₁OH). Apparently the formula of octanol is C₈H₁₇OH.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-10, 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Lu et al (U.S. 6,361,407).

Lu teaches a method of treating a wafer, which includes subjecting a wafer to a plurality of polishing steps; providing a surfactant composition solution, wherein the surfactant is characterized by a hydrophobic base selected from the group C₁ to C₁₈ alkyl and a polar functional group consisting of –OH (col.5, lines 52-63); applying the surfactant composition solution to the wafer after each of the plurality of polishing steps (paragraph, bridging col.7 and 8) and rinsing the wafer (col.9, lines 5-7). The concentration of surfactant (alcohol) in the surfactant composition solution corresponds to the claimed values (col.6, lines 13-20). Therefore, all the limitations of the instant claims are met by Lu.

5. Claim 11 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Lu et al (U.S. 6,361,407).

With regard to claim 11 Lu teaches the use of alcohol having C₁-C₁₈ alkyl group (col.5, lines 60-63), wherein the name of the alcohol, such as octanol, is omitted.

However, the reference teaches a small genus which places a claimed specie in the possession of the public, *In re Schaumann*, 197 USPQ 5, and the specie would be obvious even if the genus were not sufficiently small to justify a rejection under 35 U.S.C. 102. This rejection is made under § 102 (b) in the sense of *In re Shaumann*, 572 F.2d 312, 197 USPQ 5 (CCPA 1978) (disclosure of a small genus enables a

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species), considering the naming by Lu the alkyl groups of C1-C18 and the particular disclosing of the said compounds as evidence of particular envisionment and communication to a person of ordinary skill in the art of the non-embodied specie.

Alternatively, the disclosure of Lu provide the person of ordinary skills in the art with the motivation and a reasonable expectation of success to make and use the suggested octanol, the above render instant claims obvious.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation

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under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

9. Claims 12 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lu et al (U.S. 6,361,407) in view of WO 03/065433.

Lu does not specifically indicate the presence of ethylene oxide in the alcohol solution. However, ethylene oxide or its derivatives are conventionally utilized in the art as non-ionic surfactants and the combination of alkyl alcohol surfactant and an ethylene oxide type surfactant is described in WO'433 as an effective composition for cleaning semiconductors. Therefore, one skilled in the art motivated by WO'433 would have found obvious to add ethylene oxide into the alkyl alcohol containing composition in order to enhance wafer treating as per method of Lu with the reasonable expectation of success.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "M. Kornakov", with a long, sweeping horizontal stroke extending to the right.

Michael Kornakov
Primary Examiner
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08/04/2005